IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	)
	)
Robert W. SCHEIFLER et al.	) Group Art Unit: 2161
	)
Serial No.: 09/931,005	) Examiner: E. P. Leroux
	)
Filed: August 17, 2001	)
	) Confirmation No.: 2982
For: METHOD AND SYSTEM FOR	)
FACILITATING ACCESS TO A	)
LOOKUP SERVICE	)
	)
Mail Stop AF	)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicants request a pre-appeal brief review of the Final Office Action dated July 29, 2005 This Request is being filed concurrently with a Notice of Appeal.

I.   Requirements For Submitting a Pre-Appeal Brief Request for Review

Applicants may request a pre-appeal brief review of rejections set forth in an Office Action if (1) the application has been at least twice rejected; (2) Applicants concurrently file the Request with a Notice of Appeal prior to filing an Appeal Brief; and (3) Applicants submit a Pre-Appeal Brief Request for Review that is five (5) or less pages in length and sets forth legal or factual deficiencies in the rejections. *See* Official Gazette Notice, July 12, 2005.

Applicants have met each of these requirements and therefore request review of the Examiner's rejections in the Final Office Action for the following reasons.

II.   The Rejection of Claims 62-88 Under 36 U.S.C. § 112, ¶¶ 1 and 2, are Improper

The Examiner asserts the phrase "transforming parameters into different types for subsequent transmission" recited in claims 62, 71, 75, 78, 80, 81, and 85 is indefinite and not adequately described in the specification. (Final OA at 2-3.) Applicants traverse the Examiner's position that claims 62-88 are indefinite because "it is unclear what parameters are being transformed," and it is "difficult to determine" the "plurality of types which applicant is claiming," as asserted by the Examiner. (OA at 2.) 35 U.S.C. § 112, ¶ 2, is not a vehicle to be used by the Examiner to force Applicants into identifying exactly what parameters are transformed. As mentioned in M.P.E.P. § 2173.02, "[s]ome latitude in the manner of expression and the aptness of terms should be permitted even though the claim language is not as precise as the examiner might desire." Further, "[d]efiniteness of claim language must be analyzed, not in a vacuum, but in light of," among other things, "[t]he content of the particular application disclosure," and "[t]he claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made." (*Id.*) Here, it is clear one of ordinary skill in the art would have realized that Applicants' disclosure is related to dynamically loading stub information for remotely invoking methods or procedures in a software-based environment. The term "parameters" is well established in this field of endeavor. As such, it is improper for the Examiner to use Section 112, ¶ 2 as a tool to require Applicants to define in the above noted claims "what parameters are being transformed" and the different "types" of parameters being transmitted. Further, the mere fact the Examiner has difficulty determining what "types" are recited in these claims does not meet the requirements for rejecting the claims under 35 U.S.C. § 112, ¶ 2. "In reviewing a claim for compliance with 35 U.S.C. 112, second paragraph, the examiner must consider the claim as a whole to determine whether the claim apprises one of ordinary skill in the art of its scope and, therefore, serves the notice function required by 35 U.S.C. 112, second paragraph." (*Id.*)

Additionally, Applicants' specification adequately describes the above noted phrase. To determine compliance with the written description requirement of Section 112, ¶ 1, the Examiner is required to review the scope of the claims in view of

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specification. "Such a review is conducted from the standpoint of one of skill in the art at the time the application was filed (see, e.g., *Wang Labs. v. Toshiba Corp.*, 993 F.2d 858, 865, 26 USPQ2d 1767, 1774 (Fed. Cir. 1993)) and should include a determination of the field of the invention and the level of skill and knowledge in the art." (M.P.E.P. § 2163.02.) Moreover, "[p]rior to determining whether the disclosure satisfies the written description requirement for the claimed subject matter, the examiner should review the claims and the entire specification, including the specific embodiments, figures, and sequence listings, to understand how applicant provides support for the various features of the claimed invention." (M.P.E.P. § 2163, II(A)(2).) The Examiner has not demonstrated why one of ordinary skill in the art would have not recognized the description of a smart proxy in page 30 of Applicants' specification does not meet the written description requirement for the above noted claims. Indeed, it appears the Examiner did not even consider the disclosure of application no. 09/044,930, now U.S. Patent No. 6,393,497, that is incorporated by reference and explains the smart proxy concept. (*See* Specification at 30 and Amendment filed May 31, 2005, at 7.) Further, as explained, the "parameters" recited in the above noted claims and in page 30 of the specification would have been known to one of ordinary skill in the art in the noted field of endeavor associated with this application. Therefore, the rejection of claims 62-88 under 35 U.S.C. § 112, ¶¶ 1 and 2 are improper and should be withdrawn.

III.   The Examiner Improperly Avoided Examination of Claims 62-88 in view of the Prior Art

Applicants traverse the Examiner's position that the rejection of claims 62-88 under 35 U.S.C. § 112, ¶ 1 precludes examination in view of the prior art. (*See* Final OA at 3.) M.P.E.P. § 2163 describes guidelines that "establish the policies and procedures to be followed by Office personnel in the evaluation of any patent application for compliance with the written description requirement of 35 U.S.C. 112." As noted in the same section, "[t]hese Guidelines are intended to form part of the normal examination process. Thus, where Office personnel establish a prima facie case of lack of written description for a claim, *a thorough review of the prior art and examination on the merits for compliance with the other statutory requirements, including those of 35 U.S.C. 101, 102, 103, and 112, is to be conducted prior to*

completing an Office action which includes a rejection for lack of written description." (Emphasis added.) As such, even if the Examiner did establish a *prima facie* case of lack of written description requirement — a position Applicants traverse — the Examiner improperly avoided examination of claims 62-88 in view of any prior art. Accordingly, Applicants request these claims be examined under the other appropriate Sections of 35 U.S.C., as governed by the policies set forth in M.P.E.P. § 2163.

IV. The Examiner Did Not Establish a *Prima Facie* Case of Obviousness

To establish a *prima facie* case of obviousness, the Examiner must show, among other things, the prior art reference or references, taken alone or combined, must teach or suggest each and every element recited in the claims. (*See* M.P.E.P. § 2143.03.) In rejecting claims 28-61 under 35 U.S.C. § 103(a), the Examiner apparently misconstrues the recitation "dynamically loading executable code to facilitate access to a network service." (*See* Final OA at 4 and 10.) For instance, the Examiner assumes because the client stub *Boutcher* downloads code from a server stub, the reference discloses the above noted recitation. (*Id.* at 10.) This position is misplaced. It is clear from claim 28, for example, and Applicants' specification, that the "executable code" that is "dynamically" loaded is not the "network service," but instead is code that will "facilitate access to" the service. (*See e.g.,* claim 28, and specification at Fig. 6 and 31:4 to 32:11.) *Boutcher*, however, clearly states that client stub file already contains the necessary code used to communicate with a server for receiving results of an executed routine. (*Boutcher* at 7:14-21.) Moreover, because *Boutcher's* stubs already include this code, it is not dynamically loaded. (*Boutcher* at 8:14-21.) Therefore, it is clear that *Boutcher's* client stub merely receives results of a requested operation from a server stub and not "executable code to facilitate access to a network service." As such, the Examiner has not established a *prima facie* case of obviousness in rejecting claims 28-61 under 35 U.S.C. § 103(a).

Further, in rejecting claims 28-61, the Examiner asserts it would have been obvious to combine the cited art "for the purpose of identifying a resource on the Internet and thus enabling the client to access the resource." (*See* OA dated 3/1/05 at 5.) Applicants specifically addressed the legal deficiencies in the Examiner's position in the Amendment filed June 20, 2005, which are incorporated herein by reference. (*See*

Amendment, 6/20/05 at 32-34.) In response, the Examiner issued a Final Office Action reiterating the same rejections set forth in the March 1 Office Action, including the asserted reasons for combining the references. (*See* Final OA at 4.) In addition, the Examiner addressed Applicants' arguments by asserting the reason for the combination is taken from *Hudetz*. (*See* Final OA at 11-12.) Neither the rejections, nor the Examiner's comment on pages 11-12 of the Final Office Action meet the requirements for establishing a *prima facie* case of obviousness.

The Examiner's reason for combining the reference is conjecture. The Examiner concludes it would be obvious to combine the cited art so that "the user does not have the problem of finding and entering a URL." (*Id.*) This reasoning does not meet the standard for establishing a *prima facie* case of obviousness. For example, the Examiner does not address Applicants' arguments that there is no reason to combine the cited art. That is, *Boutcher* has no need to use a URL to locate a resource because as previously noted by Applicants, the client stub file of *Boutcher* already knows how to access the server stub file. (33-34, citing *Boutcher* at 10:7-21.) Further, the Examiner's reference to *Hudetz et al.* does not disclose or suggest a motivation for one skilled in the art for using a URL obtained from UPC labels to locate a network service or server stub. Instead, the Examiner merely quotes portions from *Hudetz et al.* that describe reasons for locating URLs that have no context to the system disclosed by *Boutcher*. Moreover, the Examiner does not point to any portion within *Boutcher* that suggests the use for such features. In fact, as explained above, these features are not needed by *Boutcher*.

In light of the above arguments and those presented in the June 20, 2005 Amendment, Applicants submit that the Examiner failed to establish a *prima facie* case of obviousness in rejecting claims 1-61. Therefore, the rejection of these claims under 35 U.S.C. § 103(a) should be withdrawn and the claims allowed.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: September 30, 2005   By:_____
                                                    Joseph E. Palys
                                                    Reg. No. 46,508